

RECEIVED
CENTRAL FAX CENTER

JUN 22 2007

Docket No. 03-03 US

REMARKS

By Office Action mailed April 26, 2007 claims 1-4, 6-15 stand rejected under §102(b) and separately under §102(a/e) and claims 3 and 13 are rejected per section 103 as discussed below. Claims 5-6 and 16-19 consequents to a requirement for election were canceled without prejudice. Amendment to claims is here presented and entry of the amendment is requested to place the application in better form for allowance or appeal.

Rejections per §102

Pursuant to §102(b), claims 1-2, 4, 7-12 and 14-15 were again rejected on Halverson, US patent 3,377,292, of record.

Applicant first refutes the Examiner's paragraph 2 as directed to claim 11 as a stark demonstration of error in ignoring a required quantitative limitation of the claim. Claim 11 requires that the composition

"...has a nearly zero magnetic susceptibility at said cryogenic temperatures."

It has escaped the Examiner's attention that claim 11 requires a *quantitative* limitation expressed in absolute terms in contrast to the relative limitation of claim 1. Moreover that quantitative property is required at "said cryogenic temperatures". The reference is completely silent on the matter of the most importance here, yet the Examiner holds that because the reference composition is "similar" the magnetic susceptibility properties (quantitatively expressed herein!) will be inherent in the prior art composition. That assertion is utterly without foundation. Applicant requests the withdrawal of the rejection of claim 11 and the dependencies thereon.

In regard to claim 1, the proposed amendment seeks to state a more exact prescription for the "selected" value of magnetic susceptibility. To that end, the context for the composition is stated and it is the value of magnetic susceptibility *of the environment* surrounding the sample to which the magnetic susceptibility of the composition is compared for substantial equalization "at cryogenic temperatures".

Claims 1-3 and 7-10 were rejected on section 102(b) citing Cheng, of record. The Examiner refused to consider the use of the composition in magnetic resonance apparatus because he considered that such context did not result in a structural difference. As presently amended, the context presents a *quantitative* property for measuring the limitation on magnetic susceptibility.

The Cheng reference has no relevance to the magnetic properties of Cheng's composition nor the temperature range applicable. The Examiner has simply asserted that the compositions are

Docket No. 03-03 US

substantially identical and (apparently by PTO practice) therefore they will exhibit the substantially the same magnetic susceptibility. The basis for such procedural pronouncement is given as

"When the PTO shows a sound basis for believing that products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." (citations)
Applicant has met such burden, *a priori*, through disclosures evidenced by figures 1 and 2 and relevant text.

The Examiner comments that even if Cheng is insufficient to establish anticipation, it would be "obvious to one of ordinary skill in the art to optimize the properties of the Gd complex as choice of its use in magnetic imaging characteristics with reasonable expectations of success." If the prior art presents no quantitative measure of magnetic susceptibility and no indication of the temperature dependence of same, there is not even an initiation of the kind of predictability that might be a starting point for the obviousness that the Examiner asserts. Accordingly, the assertion of obviousness fails.

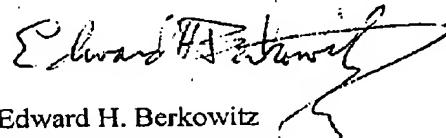
The Examiner attacks claims 3 and 13 on section 103(a) with references to Halverson and Zheng in combination. These claims depend from claims 1 and 11 and should be allowed for that reason.

Claims 7-9, dependent from claim 1 have been amended due to removal from claim 1 of the nomenclature "selected" value of magnetic susceptibility.

Conclusion

Amendment has been proposed to more precisely limit the subject matter of this work. The amended claims are properly in condition for allowance and such action is respectfully requested, or in the alternative, entry of the amendment is specifically requested to place the application in better form for appeal.

Respectfully submitted,



Edward H. Berkowitz
Attorney for Applicants
Registration No. 27,771

Date: June 22, 2007

Varian, Inc.
Legal Department
3120 Hansen Way, D-102
Palo Alto, CA 94304
(650) 424-5086